

REMARKS

By this amendment, independent claims 1, 10, 23 and dependent claims 3, 4, 6 have been amended. No new matter has been introduced. The claims have been amended to further clarify the claimed subject, and not in view of any prior art.

In the Office Action mailed on November 14, 2006, claims 1-7 and 10-15 stand rejected under 35 U.S.C. § 103(a) over U. S. Patent 6,260,029 ("*Critell*") in view of U.S. Patent Application Publication 2001/0020228 ("*Cantu*"). The examiner also relies on this combination to reject the remaining pending claims. The Examiner's rejection of claims 1-7, 10-15 is respectfully traversed.

Claim 1 is directed to a security mail envelop. The security envelop comprises a barcode in a two-dimensional symbology located on the security mail envelope. The barcode includes a public component and a private component. The public component comprises a digital signature signed by the sender and encrypted by the private key of the sender, and the private component comprises a digital signature signed by the sender and encrypted by the public key of the receiver. Applicants respectfully submit that the rejected claim 1 is not rendered obvious in view of the applied references.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim features. Additionally, the references must provide a motivation to combine in the manner suggested by the Examiner. Mere conclusory statements to combine are insufficient. Moreover, it is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.

In this case, as noted, the Examiner relies on a combination of two references, namely *Critelli* and *Cantu*, to reject claims 1-7 and 10-15. However, these two references, whether

considered alone or in combination, fail to teach all of the claimed features. In particular, neither *Critelli* nor *Cantu* at least teaches or suggests a private component that comprises a digital signature signed by the sender.

The Examiner argues that the “public component” of claim 1 corresponds to the bar code 36 (including “shipping” and “postal verification” information) in *Critelli*, and the “private component” corresponds to the “non-shipping” and “advertising” information disclosed in *Critelli*. See Final Office Action, p. 2. The Examiner further alleges that *Critelli* discloses that both the “shipping” and “non-shipping” information are signed by the sender. See, the Final Office Action (p. 2) and the Advisory Office Action (p. 2). Indeed, *Critelli* teaches that the “shipping information” (i.e., public component according to the Examiner) is signed by the sender. See *Critelli*, Col. 3, line 1 and Col. 4, lines 42-45. However, the Examiner is plainly incorrect with respect to the “non-shipping information” (i.e., private component according to the Examiner). Even a cursory review of *Critelli* reveals that the non-shipping information (“private component” according to the Examiner) is, in fact, digitally signed by a third party, and not the sender, as called for by claim 1. See *Critelli*, Col. 4, lines 10-15 (stating bar code 37 includes information signed by the third party). For this reason alone, claim 1 (and its dependent claims) are allowable. Moreover, the other pending claims are allowable for at least this reason as well.

The pending claims are allowable for an additional fundamental reason --- not only is there no requisite motivation to the combine the references in the manner suggested by the Examiner, but rather the purported combination of *Cantu* and *Critelli* actually teaches away from the claimed invention. There is no requisite motivation to combine the references because there is absolutely no basis to suggest that “electronic” messages from *Cantu* can be combined with

shipping and non-shipping information taught by *Critelli*. Notably, the two cited references, in fact, teach away from the claimed combination for reasons presented below.

The invention set forth in claim 1 is generally directed to a security mail envelope. The security mail envelope includes a barcode with two components including a public and a private component. The public component allows, for example, a third-party such as a post office to authenticate the identity of a sender by using the public key of the sender. Likewise, the private component allows the recipient of the mail envelope having its private key to access information intended for the receiver (because the public key of the receiver was used in connection with the private component).

The Examiner argues that *Critelli* teaches “public component” and “private component.” In particular, the Examiner alleges that the public component in *Critelli* corresponds to the barcode 36 because it includes “shipping information.” The Examiner alleges that non-shipping information corresponds to “private component,” which in *Critelli* is the barcode 37. See *Critelli*, col. 4, line 1-9. Thus, according to the Examiner, the “public component” of the claims corresponds to the barcode 36 of *Critelli*, whereas the “private component” corresponds to the barcode 37.

With respect to the public component, the *Critelli* reference teaches that the message is encrypted, i.e., cryptographically secured using the sender's private key. See *Critelli*, col. 3, line 1 and col. 4, lines 42-45. Moreover, *Critelli* at the same time teaches that this method of cryptographically securing technique is also applied to the non-shipping information. See *Critelli* at col. 3, lines 40-51. *Critelli* specifically describes that a cryptographic technique that is applied to the digitally signed document 100 (part of barcode 36 in Figure 2 of *Critelli* col. 2, lines 60-62) and is also applied to cryptographically secure the non-shipping information (i.e.,

the “private component” according to the Examiner). Indeed, *Critelli* teaches that the non-shipping related information is cryptographically secured, and, as noted above, this non-shipping related information of barcode 37 (“private component” according to the Examiner) is cryptographically secured using the same cryptographic technique applied to barcode 36 (i.e., using the sender’s private key). In contrast, the claims call for a “private component” in which the encryption occurs using the public key of the receiver (to allow the receiver to access the contents using his or her private key). Because *Critelli* discloses encrypting the non-shipping information using the sender’s private key, it actually teaches away from the claimed combination. At a minimum, *Critelli* undermines any motivation to combine its teachings with that of *Cantu*. In *Cantu*, the electronic message (i.e., private component, according to the Examiner) is encrypted using the public key of the receiver (See *Cantu*, paragraph [0055]), whereas the non-shipping information in *Critelli* is signed by the sender’s private key. Thus, one skilled in the pertinent art would have no motivation to combine the cited references in the manner suggested by the Examiner. For this additional reason, the claims are allowable over the cited references.

The Examiner rejects independent claim 10 for the same reasons as claim 1. However, claim 10 has additional features not recited in claim 1, and the Examiner makes no effort to address these additional features. For example, claim 10 specifies that the public component includes a “public digital mail identification,” and that the private component includes a “private digital mail identification.” The Examiner does not even attempt to argue that these features are taught or suggested by the cited references. As such, the Examiner has failed to establish a *prima facie* case of obviousness where the Examiner must show that the cited references include each and every claimed feature. For this additional reason, independent claim 10 (and all claims

depending therefrom) are allowable. Moreover, independent claim 23 (and its dependent claims) are also allowable for this same reason.

Accordingly, it is respectfully submitted that the Examiner erred in not allowing claims 1-28 over the prior art of record. Applicants respectfully request that the Examiner's rejections be withdrawn. The undersigned agent may be contacted at (713) 934-4089 with respect to any questions, comments or suggestions relating to this paper.

Respectfully submitted,
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Date: February 5, 2007

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AGENT FOR APPLICANTS

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